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In re Application of SEDERLJUNG et al.
Application No.: 10/521,653
PCT No.: PCT/SE03/01074
Int. Filing: 23 June 2003
Priority Date: 15 July 2002
Attorney Docket No.: 821-70
For: A DEVICE IN A VEHICLE ADAPTED
TO HANDLE LOADS

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: DECISION ON PETITION
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: UNDER 37 CFR 1.47(a)
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This is a decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 21 December 2005, to accept the application without the signature of joint inventor, Kurt Dahlström.

BACKGROUND

On 14 January 2005, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 22 July 2005, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 21 December 2005, applicant filed the instant petition along with a declaration, executed by the joint inventors on behalf of the deceased inventor, Kurt Dahlström and his nonsigning legal representative. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signature of deceased inventor Kurt Dahlström, alleging that Mr. Dahlström's legal representative refuses to sign the application.

DISCUSSION

Refusal of Legal Representative to Sign Application Papers

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application

or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

37 CFR 1.47 applies where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. In such cases, the last known address of the legal representative must be given (See MPEP § 409.03(e)).

The petition included the requisite \$200 petition fee, satisfying Item (1).

With respect to Item (2) above, a copy of the application papers was sent to the last known address of the nonsigning legal representative. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Here, Petitioner provided the statement of firsthand knowledge by Swedish counsel, Jan Olsson. Mr. Olsson states that he sent a letter to Ms. Dahlström along with a copy of the application papers, asking for her signature on the Declaration/Power of Attorney and Assignment. A copy of this letter was provided. Mr. Olsson states that on 2 September 2005, Ms. Dahlström contacted him by telephone indicating that she would consider the request. As of the date of the statement (5 December 2005), Mr. Olsson states that he has "heard nothing further from Johanna Dahlström, either orally or in writing...". As Ms. Dahlström did not return the declaration to Mr. Olsson, it can be concluded that she is unwilling to sign the document. Item (2) above is satisfied.

Item (3) is not satisfied because the last known address of non-signing legal representative of the deceased inventor was not provided.

With regard to item (4), the declaration executed by the available joint inventor was submitted. However, it does not satisfy the requirements of 37 CFR 1.47(a) as it does not comply with 37 CFR 1.497(a) and (b). The declaration only identifies joint inventor Max Sederljung and does not identify the deceased inventor Kurt Dahlstrom and his legal representative, Johanna Dahlström. For compliance with 37 CFR 1.497(a) and (b), the declaration must provide the citizenship, mailing address and residency of all inventors, including that of the deceased inventor and the legal representative.

In sum, Petitioner has satisfied Items (1) and (2) above. For the reasons set forth above, applicant has not satisfied Items (3) and (4) above. It is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

Status under 37 CFR 1.42

Pursuant to 37 CFR 1.42, first sentence:

"In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

The legal representative of a deceased inventor must make the application for patent "on the same terms and conditions applicable to the inventor." 35 U.S.C. 117. To this end, 37 CFR 1.497(b)(2) states, in pertinent part,:

"If the person making the oath or declaration or any supplemental declaration is not the inventor (§§1.42, 1.43 or §1.47), the oath or declaration shall state the relationship of the person to the inventor...and the citizenship, residence and mailing address of the legal representative".

37 CFR 1.497(b)(2) requires the declaration to *state the relationship* of the person(s) (under 37 CFR 1.42) making the declaration for a deceased inventor and *state the citizenship, residency and mailing address of the heir(s)/legal representative* as well as that of the deceased inventor. The declaration does not provide the citizenship, residency and last known mailing address for the deceased inventor and for his legal representative. The declaration must identify Johanna Dahlström as the legal representative of Kurt Dahlström as required by 37 CFR 1.497(b)(2).

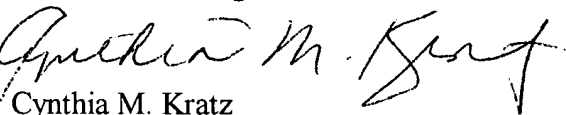
In sum, with regard to the petition under 37 CFR 1.47(a), items (3) and (4) above are not satisfied. Petitioner has not demonstrated that the legal representative Johanna Dahlström refuses to sign. For the reasons set forth above, the declaration submitted 21 December 2005 does not comply with 37 CFR 1.497(b) and is unacceptable. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time. The request for status under 37 CFR 1.42 is also refused at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**. The request for status under 37 CFR 1.42 is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) and 1.42 must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a) and Request for Status under 37 CFR 1.42." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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